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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/766,877	01/30/2004	Mark Serpa	067517-0012	4102
31824 7590 07/26/2007 MCDERMOTT WILL & EMERY LLP 18191 VON KARMAN AVE. SUITE 500 IRVINE, CA 92612-7108			EXAMINER LEE, BETTY E	
			ART UNIT 2616	PAPER NUMBER
			MAIL DATE 07/26/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/766,877	Applicant(s) SERPA ET AL.	
	Examiner Betty Lee	Art Unit 2616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 January 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 24-36 is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☒ Claim(s) 5-23 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims **1 and 2** are rejected under 35 U.S.C. 102(e) as being anticipated by Poustchi et al. (US 2005/0117525).

Regarding claim 1, Poustchi teaches assigning a unique identifier to a peer including at least a first peer and a second peer (see paragraph 34 lines 9-12);

uploading a unique identifier of the first peer to the second peer (see paragraph 35 lines 12-13);

uploading a unique identifier of the second peer to the first peer (see paragraph 35 lines 1-7);

assigning at the first peer a state of the second peer to an active state or an inactive state (see paragraph 35 lines 1-7); and

assigning at the second peer a state of the first peer to an active state or an inactive state (see paragraph 35 lines 1-7).

Regarding claim 2, Poustchi teaches building a peer list on a peer, the peer list comprising the unique identifiers uploaded to the peer; and displaying the peer list (see paragraph 36 lines 1-4).

3. Claims **1 and 2** are rejected under 35 U.S.C. 102(e) as being anticipated by Jonsson et al. (US 7,164,885).

Regarding claim 1, Jonsson teaches assigning a unique identifier to a peer including at least a first peer and a second peer (see col. 5 lines 36-48);

uploading a unique identifier of the first peer to the second peer (see col. 5 line 64 – col. 6 line 9);

uploading a unique identifier of the second peer to the first peer (see col. 5 line 64 – col. 6 line 9);

assigning at the first peer a state of the second peer to an active state or an inactive state (see col. 8 lines 52-63); and

assigning at the second peer a state of the first peer to an active state or an inactive state (see col. 8 lines 52-63).

Regarding claim 2, Jonsson teaches building a peer list on a peer, the peer list comprising the unique identifiers uploaded to the peer; and displaying the peer list (see col. 7 lines 30-40)

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 3-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jonsson et al. (US 7,164,885) in view of Klassen et al. (US 2005/0113118).

Regarding claim 3, Jonsson teaches building a peer list via Bluetooth peer detection (see col. 7 lines 30-40). Jonsson teaches all the subject matter of the claimed invention with the exception of personalizing the peer list. However, Klassen teaches personalizing the peer list by entering personalized information for peers on the peer list (see paragraph 41 lines 1-6); and displaying the personalized information when displaying the peer list (see Fig. 4). Thus, it would have been obvious to one of ordinary skill in the art to use the system of Klassen in the system of Jonsson. The motivation for doing so is to make the system more user-friendly by allowing the identification of peers using personalized information.

Regarding claim 4, Jonsson teaches all the subject matter of the claimed invention with the exception of personalizing the peer list. However, Klassen teaches entering personal information of a user into a peer (see paragraph 41 lines 1-6);

Uploading the personal information when uploading the peer's unique identifier to another peer (see paragraph 41 lines 1-6);

including the personal information when building a peer list (see paragraph 51 lines 1-8); and

displaying the personal information when displaying the peer list (see Fig. 4).

Thus, it would have been obvious to one of ordinary skill in the art to use the system of Klassen in the system of Jonsson. The motivation for doing so is to make the system more user-friendly by allowing the identification of peers using personalized information.

Allowable Subject Matter

8. Claims **5-23** are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
9. Claims **24-36** are allowed.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Betzler (US 2003/0126213), Beasley et al. (US 2004/0106408), Jung et al. (US 2005/0136901), Fernandez et al. (US 2004/0249953), and Hester et al. (US 2005/0058084) are all cited to show systems which are considered pertinent to the claimed invention.


11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Betty Lee whose telephone number is (571) 270-1412. The examiner can normally be reached on Monday-Thursday 9-5 EST and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hassan Kizou can be reached on (571) 272-3088. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2616

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

BL



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